

Attorney Docket No.: P-US-TN-3305
Application Serial No.: 10/688,668

REMARKS

The Office Action dated July 18, 2011, has been received and carefully noted. The above amendments and the following remarks are submitted as a full and complete response thereto.

By this Amendment, claims 83-86 have been canceled, claims 1, 66 and 67 have been amended and claim 87 has been added. No new matter is presented. Support for new claim 87 can be found in at least Figure 8 of the application as originally filed. Claims 1, 3, 5, 66-69, 71, 80, 81, and 87 are pending and respectfully submitted for consideration.

Rejections Under 35 U.S.C. § 103

Claims 1-3, 5 and 85

Claims 1-3, 5 and 85 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith et al. (U.S. Patent No. 6,347,624, "Smith") in view of Tsao (U.S. Patent No. 6,263,866) and further in view of Greenland (U.S. Patent No. 6,276,990, "Greenland"). As noted in the previous Responses filed October 15, 2010 and May 5, 2011, claim 2 has been canceled. Claim 85 has been canceled. Claims 3 and 5 depend from claim 1.

Smith was cited for disclosing many of the claimed elements of the invention with the exception of a first rail being adjustable in a direction lateral to the longitudinal axis, a motor assembly pivotably supported by a support assembly, and a switch disposed above the table and proximate to the motor assembly. Tsao and Greenland were cited for curing these deficiencies. The Applicant traverses the rejection and respectfully submits that claims 1, 3, and 5 recite subject matter that is neither disclosed nor suggested by the cited references.

Claim 1, as amended, recites, in part, "a first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis."

The Office Action acknowledged that Smith does not disclose that the rail is adjustable in a direction lateral to the longitudinal axis. Tsao was cited for teaching "designing the rail system to be adjustable by utilizing a plurality of transverse screw holes to attach the rails to the frame (col. 2, lines 7-12)." See page 3 of the Office Action. The Office Action further stated that "[i]t...would have been obvious...to have incorporated elongated screw holes with the Smith rail

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and frame system to provide for the adjustability of the rails....” See page 4, lines 1-5 of the Office Action.

The Applicant respectfully disagrees that it would have been obvious to combine Smith and Tsao as suggested in the Office Action. The Office Action asserted that the outer rail 310 in Smith was comparable to the claimed first rail. Smith discloses that the outer rails 310, 320, the bottom rail 330 and the end rail 340 form a generally rectangular frame. See column 6, lines 34-36 of Smith. Therefore, it would not have been obvious to one of ordinary skill in the art to modify the outer rail 310 of Smith to be adjustable relative to the frame 300 because the outer rail of Smith forms the frame, which is not adjustable with respect to itself.

In addition, it would not have been obvious to incorporate the teachings of Tsao in Smith because to do so would change the principle of operation of the Smith reference. Under U.S. patent practice, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (The court reversed the rejection holding the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” 270 F.2d at 813, 123 USPQ at 352). See MPEP §2143.01. In this case, Tsao discloses a platform 23 having a tubular slider integrated on one side which is slidably wrapped on the guide rod 224 of the frame 22. See column 2, lines 13-15 of Tsao. As can be seen in the drawings, Tsao only has the slide on one side of the platform. Smith, however, teaches rollers attached to the underside of table 210 on both sides that roll inside of substantially enclosed tracks formed on the interior of outer rails 310, 320. The outer rails form the frame 300. As such, any lateral adjustment to the outer rail 310, as suggested in the Office Action, would require substantial reconstruction and redesign of the entire rectangular frame 300 of the tile saw in Smith. Therefore, the Applicant respectfully submits that Smith is not properly combinable with Tsao to teach a first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis, as recited in claim 1.

Greenland fails to cure the deficiencies in the combination of Smith and Tsao as Greenland also does not disclose or suggest at least the feature of a first rail disposed on the

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frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis.

As such, the Office Action has not set forth a *prima facie* case of obviousness of claim 1. In view of the above, the Applicant respectfully submits that claim 1 is allowable and requests withdrawal of the rejection of claim 1 and dependent claims 3, and 5.

Claim 71

Claim 71 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and further in view of Greenland and Sigetich et al. (U.S. Patent No. 4,428,159).

Claim 71 depends from claim 1 and recites that the switch comprises a single throw, double pole switch.

The Applicant traverses the rejections and respectfully submits that claim 71 recites subject matter that is neither disclosed nor suggested by the cited references as the claim depends from claim 1, which is allowable for the reasons submitted above.

Claim 80

Claim 80 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and further in view of Greenland and further in view of Lee (U.S. Patent No. 5,676,124), Jameson (U.S. Patent No. 3,777,792), Weissman (U.S. Patent No. 4,885,956), Mayfield (U.S. Patent No. 5,063,806), Rueb (U.S. Patent No. 5,577,428), Welch (U.S. Patent No. 5,906,528) and Gorgol et al. (U.S. Patent No. 6,273,081).

Claim 80 depends from claim 1 and recites that the support assembly comprises a support member disposed on at least one of the base and the frame assembly, and a generally U-shaped member coupled to the support member, the switch being disposed on the generally U-shaped member.

The Applicant traverses the rejections and respectfully submits that claim 80 recites subject matter that is neither disclosed nor suggested by the cited references, as claim 80 depends from claim 1, which is allowable for the reasons submitted above.

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Claims 67-68, 83 and 84

Claims 67-68, 83 and 84 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and of Greenland and further in view of Lee, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol.

As a preliminary matter, it appears that the Office Action rejection includes claim 66 as indicated in the Office Action Summary. Clarification is requested.

Claims 83 and 84 have been canceled.

Smith was cited for disclosing many of the claimed elements of the invention with the exception of a first rail being adjustable in a direction lateral to the longitudinal axis, a motor assembly pivotably supported by a support assembly, a switch disposed on the support assembly so that when the motor assembly is pivoted about the bevel axis, the switch remains stationary. Tsao, Greenland, Lee, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol were cited for curing these deficiencies. Claim 68 depends from claim 67. The Applicant traverses the rejection and respectfully submits that claims 66-6, recite subject matter that is neither disclosed nor suggested by the cited references.

Claims 66 and 67, recite, in part, "first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis." The Office Action asserted that the outer rail 310 of Smith was comparable to the claimed first rail. The Office Action also acknowledged that Smith does not disclose first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable in a direction lateral to the longitudinal axis. Tsao was cited for teaching an adjustable rail. However, as discussed above, Smith is not properly combinable with Tsao to teach this feature of the invention because the outer rail 310 of Smith, which forms the frame 300, is not adjustable with respect to itself. In addition, adjusting the outer rail 310 in Smith would require a substantial reconstruction and design of the elements forming not only the frame 300, but the table and inner rails that roll on a substantially enclosed track formed on the outer rail 310.

Greenland fails to cure this deficiency as the reference also does not teach or suggest a first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis.

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Further, none of Lee, Jameson, Weissman, Mayfield, Rueb Welch, or Gorgol cures the deficiencies in Smith, Tsao and Greenland, as these references also do not teach or suggest a first rail disposed on the frame assembly, the first rail having a longitudinal axis and being adjustable relative to the frame in a direction lateral to the longitudinal axis.

Additionally, none of the cited references teach or suggest a switch electrically connected to the motor assembly and disposed on the support assembly, so that when the motor assembly is pivoted about the bevel axis, the switch remains stationary. All of the references disclose either a non-pivoting or stationary motor assembly (Jameson, Weissman, Mayfield, Rueb, Welch, Gorgol) or a switch that moves with a pivoting motor assembly (Greenland, Lee). None of the numerous cited references teach or suggest the claimed feature of a stationary switch disposed apart from the moving parts and moving motor of a saw.

As the combination of references do not teach or suggest the features of the invention as recited in claims 66 and 67, the Office Action has not set forth a *prima facie* case of obviousness of claims 66 and 67, and therefore, dependent claims 68.

Accordingly, the Applicant respectfully submits that claims 66 and 67 and dependent claim 68 are allowable.

Claim 69

With respect to claim 69, the Applicant respectfully requests clarification on the references cited. Claim 69 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsao in view of Smith [it appears that the Office Action meant Smith in view of Tsao] and of Greenland and further in view of Lee, Jameson, Weissman, Mayfield, Rueb, Welch, Gorgol and further in view of McCambridge et al. (U.S. Patent No. 4,350,193), Marcoux et al. (U.S. Patent No. 3,342,226), Brenta (U.S. Patent No. 4,105,055), Sanfilippo (U.S. Patent No. 6,745,803) and Otto (U.S. Patent No. 5,161,590).

Claim 69 depends from claim 67 and recites that the support member includes an electrical outlet. The Applicant traverses the rejections and respectfully submits that claim 69 recites subject matter that is neither disclosed nor suggested by the cited references, as claim 69 depends from claim 67, which is allowable for the reasons submitted above.

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Claim 81

Claim 81 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and of Greenland and further in view of Lee '961, Jameson, Weissman, Mayfield, Rueb, Welch, and Gorgol and further in view of Sigetich.

Claim 81 depends from claim 66 and recites that the switch comprises a single throw, double pole switch.

The Applicant traverses the rejections and respectfully submits that claim 81 recites subject matter that is neither disclosed nor suggested by the cited references as the claim depends from claim 66, which is allowable for the reasons submitted above.

Claim 86

Claim 86 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Smith in view of Tsao and further in view of Greenland. As claim 86 has been canceled, the rejection is now rendered moot.

Conclusion

The Applicant does not acquiesce to the characterizations of the art. For brevity and to advance prosecution, however, the Applicant has not addressed all characterizations of the art, but reserve the right to do so in further prosecution of this or a subsequent application. Moreover, there may be alternative or additional reasons for patentability not discussed in this response.

Should the Examiner believe anything further is desirable in order to place this application in better condition for allowance, the Examiner is requested to contact the undersigned at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension, together with any

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additional fees that may be due with respect to this paper, may be charged to counsel's deposit account No. 02-2548, referencing Attorney Dkt. No. P-US-TN-3305.

Respectfully submitted,

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Enclosures: Request for Continued Examination
Petition for Extension of Time (2 months)
Request for Examiner Interview